



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

PL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,763	12/06/2001	Jeffrey S. Larson	WAVE1100-1	2045
7590	05/09/2007		EXAMINER	
Robert C. Kowert Meyertons, Hood, Kivlin, Kowert & Goetzl, P.C. P.O. Box 398 Austin, TX 78767-0398			TRAN, MAIT	
			ART UNIT	PAPER NUMBER
			2129	
			MAIL DATE	DELIVERY MODE
			05/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)
	10/006,763	LARSON ET AL.
	Examiner Mai T. Tran	Art Unit 2129

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 23 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- The period for reply expires _____ months from the mailing date of the final rejection.
- The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- They raise new issues that would require further consideration and/or search (see NOTE below);
- They raise the issue of new matter (see NOTE below);
- They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.

13. Other: _____.


5/16/07
David Vincent
Supervisory Patent Examiner
Tech Center 2100

Continuation of 11. does NOT place the application in condition for allowance because: 'Applicants' arguments have been fully considered but they are not persuasive. Specifically:

Argument 1:

Applicants claims clearly recite a practical application, and not a judicial exception of an abstract idea, law of nature or natural phenomenon. For example, claim 1 recites a computer program process generating an association between information objects and user defined for different computer-implemented source resources. The practical application for generating such an association in a computer system is clearly described in Applicants' specification, for example, to synchronize updates to different accounts on different computer-implemented source resources for the same user. This is clearly not an abstract idea, but a real world application. The association generated by the computer program process is clearly a useful, concrete and tangible result. For example, the association may be stored as a virtual identity in an index as illustrated in FIG. 3. This is clearly a useful, concrete and tangible result. An association generated in a computer system clearly has a concrete and tangible form as data in the computer system. Also, the usefulness is also clearly described in the specification, such as to synchronize updates to different accounts on different computer-implemented source resources for the same user. The Examiner has never provided any explanation of why the computer program process generated association of claim 1 is not a useful, concrete and tangible result. Thus, the Examiner's rejection is completely conclusory and improper.

In response to Applicants' assertion that "the association generated by the computer program process is clearly a useful, concrete, and tangible result." Examiner disagrees. In the instant case, Examiner notes that the plain, ordinary, and accustomed meaning of the term "association" generally corresponds to a group of individuals or people. Examiner further notes that an "association" may be a relationship, a link between two elements or variables, a logical connection or simply puts it data in the computer art. Because Applicants' claimed invention is not generating a group of individuals or people, Examiner finds the later interpretation to be consistent with Applicants' claim limitation. Data in a modern digital computer usually is in binary form or pure mathematical numbers. How can pure math be statutory? Also, regarding Applicants' assertion that the association may be stored as a virtual identity in an index as illustrated in Fig. 3, it should be noted that this limitation is not recited in any independent claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the claimed invention fails to produce a useful, concrete, and tangible (i.e. non-abstract) result. On this basis, the rejection under 35 U.S.C. 101 stands.

Argument 2:

Moreover, the Examiner's rejection does not follow the Office Guidelines on patentable subject matter. According to the most recent Office Guidelines on patentable subject matter, the "useful, concrete and tangible result" analysis only applies if the Examiner has first established a *prima facie* case that the claimed invention claimed invention covers a law of nature, natural phenomenon or abstract idea. See Guidelines IV.C.1. Since the Examiner has never explained how the invention of claim 1 covers a law of nature, natural phenomenon or abstract idea, the Examiner has failed to state a proper rejection. Applicants claims are clearly not directed to a law of nature, natural phenomenon or abstract idea. For example, claim 1 is specific to a computer-implemented source resource containing a set of information objects that defines a set of users. Claim 1 also requires using the source resource definition for each source resource to discover the set of users from the source resource. Claim 1 also requires defining an additional resource containing a second set of information objects that corresponds to a user from the set of users, and using the additional resource definition to discover the second set of information objects from the additional resource. Moreover, claim 1 requires generating an association of each information object from the second set of information objects with the corresponding user from the set of users and with the additional resource. Clearly, claim 1 does not cover a law of nature, natural phenomena or abstract idea. There is nothing abstract about the method of claim 1. The Examiner's assertion that claim 1 is directed to an abstract idea is entirely conclusory and is not based on any logical reasoning. Claim 1 is clearly directed to a very practical application. As stated in the Guidelines at IV.C.2.b: "The claim must be examined to see if it includes anything more than a § 101 judicial exception [e.g., abstract idea]. If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world ... then the claim meets the statutory requirement of 35 U.S.C. § 101." (emphasis added). Since the Examiner has never explained how the invention of claim 1 covers a law of nature, natural phenomenon or abstract idea, the Examiner has failed to state a proper rejection.

In response, the Examiner disagrees. In the Office Action dated 8/23/06, claims 1-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non statutory subject matter.

Claims 1-20 and 33-59 are directed to method claims. However, the steps in these method claims are broadly but reasonably interpreted as functional descriptive material i.e. computer programs *per se*. The intrinsic evidence to support this interpretation is found in the specification, page 10, paragraph [0031], line 12, page 12, paragraph [0036], line 7 (software program 240), etc... Computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized (MPEP 2106.01).

Claims 21-32 are directed to system claims. However, these system claims do not have any particular or special structure i.e. any particular or special hardware different than a mere general computer that manipulates data by performing mathematical operations. "The determination of whether a claimed method is a 'process' within the meaning of 35 U.S.C. 101 is unaffected by the particular apparatus for carrying out the method" (*In re Grams* 12 USPQ2d 1824, 1829 (Fed. Cir. 1989)).

Therefore, the Examiner has not failed to state a proper rejection. On this basis, the rejection under 35 U.S.C. 101 stands.

Argument 3:

Furthermore, as discussed above, the invention as recited in claim 1 clearly provides a useful, concrete and tangible result. Claim 1 recites generating an association of each information object from a second set of information objects with the corresponding user from a set of users and with an additional resource. The Examiner states that the claimed invention is silent about any tangible result that comes after the generating. However, the generated association is a useful, concrete and tangible result. According to the Guidelines, "The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing." (emphasis added). Moreover, the association generated by a computer program process would inherently constitute tangible data within a computer.

Applicants refer the Examiner to *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) where the court stated that the relevant claim was statutory because "the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application ... because it produces 'a useful, concrete and tangible result' — a final share price". Just like the implicitly produced final share price in *State Street* was considered a useful, concrete and tangible result and thus statutory, the explicitly generated association of each information object from a second set of information objects with the corresponding user from a set of users and with an additional resource, as recited in claim 1, is clearly a useful, concrete and tangible result and is thus statutory. Note that the final share price was not even explicitly recited in the claim in *State Street*. Moreover, as discussed by the court in *State Street*, the final share price was tangible as data in a computer system. The same analysis as in *State Street* applies to the generated association of claim 1.

In response, the Examiner disagrees. Examiner notes that Applicants seek to analogize their case to the facts in *State Street Bank & Trust Co. v Signature Fin. Group, Inc.*, 149 F.3d 1368. Examiner finds that the two cases are not the same or similar.

The issues in *State Street* turned on the "transformation of discrete dollar values" as an example of a practical application that was "useful, concrete and tangible." In fact, the Court expressly and specifically addressed this point when it held that:

Today we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation because it produces 'a useful, concrete and tangible result' — a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades. (emphasis added) *State Street Bank* at 1601.

True enough, that case later eliminated the "business method exception" in order to show that business methods were not per se nonstatutory, but the court clearly did not go so far as to make business methods per se statutory. A plain reading of the excerpt above shows that the Court was very specific in its definition of the new practical application. It would have been much easier for the court to say that "business methods were per se statutory" than it was to define the practical application in the case as "...the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price..."

The court was being very specific.

Additionally, the court was also careful to specify that the "useful, concrete and tangible result" it found was "a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." (i.e. the trading activity is the further practical use of the real world monetary data beyond the transformation in the computer — i.e., "post-processing activity")

Applicants cite no such specific results to define a useful, concrete and tangible result. Neither do Applicants specify the associated practical application with the kind of specificity the Federal Circuit used. On this basis, Applicants have not shifted their burden of showing that their claims are statutory and Examiner's rejection of those claims STANDS.

Argument 4:

Even more on point, Applicants also refer the Examiner to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). The claim in the AT&T case recites "generating a message record" and was held to be statutory. In regard to patentable subject matter, there is no difference between the generated message record in AT&T and the generated association of claim 1 in regard to statutory subject matter. In the Final Action, the Examiner questions the similarity of the association generated by the computer program process with the message record generated in AT&T. In response, Applicants note that the same reasoning applied by the Federal Circuit to the generated message record in AT&T applies to the generated association of claim 1. The generated association of claim 1 is every bit as useful, concrete and tangible as the message record of AT&T. The Examiner has not provided any basis for distinguishing the claim in AT&T from the claims of the present application.

In response to Applicants' assertion that the claim in the AT&T case recites "generating a message record" and was held to be statutory. Applicants are respectfully requested to give a complete citation of this quote.

Here is the claim in the AT&T case:

A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of:

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

and here is the decision:

The PIC indicator represents information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC's subscriber. Because the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of Section 101.

Applicants cite no such specific results to define a useful, concrete and tangible result with the kind of specificity the Federal Circuit used. On this basis, Applicants have not shifted their burden of showing that their claims are statutory and Examiner's rejection of those claims STANDS.